

REMARKS

For the convenience of the Examiner set forth below is a recapitulation of the current status of the Claims in the present Application.

CLAIMS	STATUS	DEPENDENCY
1	Canceled	—
2	Canceled	—
3	Canceled	—
4	Canceled	—
5	Canceled	—
6	New	Independent
7	New	6
8	New	6
9	New	6
10	New	6
11	New	6
12	New	6
13	New	12
14	New	13
15	New	13
16	New	12

Comments of Examiner Conrad R. BLEASE have been reviewed carefully along with pertinent sections of the Patent Act, Patent Rules, the Manual of Patent Examining Procedure, legal treatises and relevant decisional law. The Application has been amended in accordance with

Examiner BLEASE's requirements and allowance of the Application, as amended, is solicited earnestly.

Claim 1 has been rejected under 35 USC 102(b) as being anticipated by US Patent No. 5,497,049, *Fischer*, 1996.

Claim 2 has been rejected under 35 USC 103(a) as being unpatentable over US Patent No. 5,497,049, *Fischer*, 1996.

Claims 3-5 have been objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can only refer to preceding claims in the alternative.

The Examiner has stated the application fails to meet the requirements of 35 USC 112, first and second paragraph has provided a citation related to the specification.

Accordingly the Specification has been amended in accordance with the Examiner's comments. The text of the Specification, as filed, has been reordered and reorganized to provide the following sections: Title, Background of the Invention, Objects and Summary of the Invention, Brief Description of the Drawings, Detailed Description of the Invention, Abstract of the Disclosure.

No new matter has been added.

The text of the Specification has also been amended to correct grammatical errors and to conform to proper English usage.

Claims 1-5 have been cancelled and the subject matter of Claims 1-5 has been presented in claims 6-15 in order to resolve informalities in the claim format. No new subject matter has been added. Claims 6-15 are believed to be patentable.

Reconsideration of the rejection of Claims 1-5 is requested on the following basis Examination of the *Fischer* (US 5,497,049) reference reveals the following difference between the cited reference the structure of the present invention and the statements of the Examiner.

1. The *Fischer* (US 5,497,049) reference does not teach or suggest the structure and operation of the present invention.

2. The *Fischer* (US 5,497,049) reference provides a spherical discharge space which has an outer surface 7, as shown in Fischer's Fig. 1. *Fischer* (US 5,497,049) discloses a lamp which is similar to the arc tube portion of the present invention. However, *Fischer* (US 5,497,049) does not disclose the tubular envelope which forms a key element of the present invention as claimed in claim 1 nor does *Fischer* (US 5,497,049) disclose the key relationship between the arc tube and the tubular envelope as described and as claimed.

3. *Fischer* (US 5,497,049) does not disclose a tubular element of any kind and does not disclose any structure which leads to the tubular element which forms a gas tight seal with the arc lamp as provided in the present invention.

4. *Fischer* (US 5,497,049) does not disclose the bell shaped structure of the present invention as described and as claimed.

5. *Fischer* (US 5,497,049) does not describe any structure which surrounds the arc tube and which has a ball shape complementing the ball shape of the arc tube.

6. *Fischer* (US 5,497,049) does not disclose or suggest any structure which provides reduced glare, increased ruggedness and increased effectiveness of the light beam as provided by the present invention and as described and as claimed.

6. *Fischer* (US 5,497,049) cannot provide the reduced glare and the uniform temperature provided by the structure of the present invention.

7. The Examiner has cited claims 2, 3, 4 and 12 of *Fischer* (US 5,497,049) as showing a cap. However, review of *Fischer* (US 5,497,049) shows that the cap in *Fischer* (US 5,497,049) is not similar to the cap in the present invention. *Fischer* (US 5,497,049) shows a cap, reference number 10, in

Fischer (US 5,497,049), Fig. 2 which has protrusions 12 which contact the outside of an arc tube 1. In the present invention protrusions do not contact the arc tube.

8. The present invention shows and claims a hoop member which encircles the tubular envelope. In the present invention the tubular envelope comprises several individual portions which cooperate to encircle and support the tubular envelope.

9. *Fischer* (US 5,497,049) does not show a hoop member of any kind.

10. *Fischer* (US 5,497,049) cannot provide the reduced glare and the uniform temperature provided by the present invention which result from the structure of the present invention.

11. *Fischer* (US 5,497,049) cannot provide the thermal stability, vibration ruggedness and improved illumination provided by the present invention which result from the structure of the present invention.

For the above reasons the application of the *Fischer* (US 5,497,049) reference is not considered to be appropriate.

In a famous footnote in Hodosh v. Block Drug Co., 786 F. 2d 1136, 229 USPQ 182, 1897 (Fed. Cir. 1986), the Federal Circuit set out five principles, with citations to previous cases, regarding obviousness determinations under Section 103. The footnote (as to the first four principles) reads as follows:

Our comments on the district court's obviousness determination generally include the following tenets of patent law that must be adhered to when applying § 103:

- (1) the claimed invention must be considered as a whole (35 USC 103); see, e.g., Jones v. Harty, 727 F. 2d 1524, 1529, 220 USPQ 1021, 1024 (Fed. Cir. 1984) though the differences between claimed invention and prior art may seem slight, it may also have been taken the key to advancement of the art);

- (2) the references must be considered as a whole and suggest the desirability and thus the obviousness of making the combination (see, e.g., Lindermann Machinenfabrik GmbH v. American Hoist & Derrick Co., 730 F. 2d 1452, 1462, 220 USPQ 481, 488 (Fed. Cir. 1984))
- (3) the references must be viewed without the benefit of hindsight version afforded by the claimed invention (e.g. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F. 2d 1540, 1553, 220 USPQ 330, 313 (Fed. Cir. 1983));
- (4) “ought to be tried” is not the standard with which obviousness is determined (Jones, *supra*, 727 F. 2d at 1530, 220 USPQ at 1026).

The fifth tenet or principle deals with the presumption of validity and is not germane to the issues here involved.

It is submitted that the Examiner’s position in applying *Fischer* is contrary to the above quoted tenets of the Court of Appeals for the Federal Circuit, particularly the first three. When the claimed invention is considered fairly as a whole, it is self-evident that Applicant’s Invention is not rendered obvious by the cited prior art, whether considered alone or in combination.

The statutory presumption of 35 USC § 282 makes an invention presumptively non-obvious unless the Examiner can demonstrate that “the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skills in the art to which said subject matter pertains,” 35 USC § 103.

Obviousness is a legal conclusion based on four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the prior art and the claimed Invention; (3) the level of the ordinary skill when the invention was made; and (4) any other objective considerations including

evidence of commercial successes, copying, and a long-felt need in the industry. Continental Can Co. v. Monsanto Co., 948 F. 2d 1264, 1270, 1273 (Fed. Cir. 1991) (citing Graham v. Deere Co., 383 US 1.17 (1966)). The decision maker is not to apply hindsight, but must analyze obviousness from the viewpoint of a person skilled in the art prior to the disclosure of the present invention Pandult Corp. v. Dennis Mfg. Co., 810 F. 2d 1561, 1566 (Fed. Cir.), cert denied, 481 US 62 (1987).

Objective evidence of non-obviousness (long-felt need, commercial success, copying must always be taken into account; it is not merely “icing on the cake”. Hybrietch, Inc. v. Monoclonal Antibodies, Inc., 802 F. 2d 12367, 1380 (Fed. Cir. 1986), cert denied, 4580 US 974 (1987). The Federal Circuit has stated that:

(I)ndeed, evidence of secondary considerations may often be the most probative and cogent evidence in the record it may often establish that an invention appearing to have been obvious in light of the prior art was not.

The Examiner has attempted to reconstruct Applicant’s invention from selecting bits and pieces from the *Fischer* reference. The cherry picking exercise is just the sort of hindsight reconstruction which the Federal Circuit has warned against repeatedly. Nothing in the prior art suggest to a person of ordinary skill in the art to combine those elements in the way Applicant did to arrive at his invention. Pandult Corp., 810 F.2d at 1568. The prior art existed for many years and yet those skilled in the art never created a high intensity discharge lamp with low glare and high efficiency for vehicles comparable to Applicant’s. See Id. at 1577 (that skilled workers did not create (patented) Invention, despite existence of elements in the prior art, is evidencing of non-obviousness).

The objective evidence, such as whether the invention solves a long-standing problem, weighs strongly in favor of a conclusion that Applicant's Invention is not obvious. (Continental Can, 948 F. 2d at 1273).

The status of the Claims is as follows:

Claims 1-5 are canceled.

Claims 6-16 are new.

In view of the foregoing amendments, submissions and explanations, it is believed that claims 6-16 are in condition for allowance. An early Notice of Allowance on the Application will be appreciated.

Courtesy, cooperation and skill of Examiner Conrad R. BLEASE are appreciated and acknowledged.

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Respectfully,
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